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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/784,179  | 02/16/2001  | Veronique Chevalier  | 202443US0           | 3089             |
| 22850   | 7590        | 05/18/2004           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | WANG, SHENGJUN      |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 1617                 |                     |                  |

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/784,179             | CHEVALIER ET AL.    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Shengjun Wang          | 1617                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 June 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Description of Claims

4) Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on June 3, 2003 has been entered.

### ***Double Patenting Rejections***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 6,423,854 in view of Philippe et al. (WO 99/10318, of record). '854 claims cosmetic regimentation composition comprising aminophenols and method of using the same for depigmentation. N-cholesteryloxycarbonyl-4-aminophenol is among the preferred aminophenol (claim 2), and the composition may further comprise other depigmentation agent (claim 18).

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4. ‘854 does not expressly claim composition comprising N-cholesteryloxycarbonyl-4-aminophenol and hydroquinone compound.

5. However, Philippe et al. teaches that hydroquinone compounds are well-known depigmentation compounds, and are useful in combination with aminophenol compound for depigmentation. See, particularly, page 7.

6. Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a depigmentation composition comprising N-cholesteryloxycarbonyl-4-aminophenol and hydroquinone compound because hydroquinone compound are well-known depigmentation agent.

7. Claims 1-23 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 37-39 and 47 of copending Application No. 10/125411 in view of Philippe et al. (WO 99/10318, IDS).

8. The claims of ‘411 are drawn to cosmetic composition comprises N-cholesteryloxycarbonyl-4-aminophenol and method of using the same for depigmentation.

9. ‘411 does not expressly claim the composition further comprise hydroquinone compounds. However, Philippe et al. discloses that hydroquinone compounds are well-known depigmentation agents, and suggest the usefulness of the combination of aminophenol and hydroquinone compound for depigmentation. See, particularly, page 7.

Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a depigmentation composition comprising N-cholesteryloxycarbonyl-4-aminophenol and hydroquinone compound because hydroquinone compound are well-known depigmentation agent. It is *prima facie* obvious to

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combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of two known depigmentation agents sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections 35 U.S.C. 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Philippe et al. (WO 99/10318, of record).

12. Philippe et al. teach the use of aminophenol derivatives in cosmetic for depigmenting and/or bleaching skin or hair (see the abstract). A preferred derivative is N-cholesteryloxycarbonyl-4-aminophenol (see page 4, lines 35-40; and example 3, page 8, line 17-29). Composition comprising 0.001-10% by weight of the aminophenol are taught (see page 6, lines 1-3). Lipid vesicles are taught (see page 6, lines 5-11 and 27-29). The reference teaches that the aminophenol derivatives, when combined with other depigmenting agents, such as hydroquinone compounds, allow the hydroquinone to be used at doses that are less toxic to the skin and that when the components are incompatible, they can be incorporated in vesicles (see pages 7, lines 11-21).

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13. Philippe et al do not teach expressly the combination herein, or the particular amounts of each component.

However, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to use N-cholesteryloxycarbonyl-4-aminophenol as the aminophenol and combined with hydroquinone compounds as herein claimed.

One of ordinary skill in the art would have been motivated to make and use such combination because N-cholesteryloxycarbonyl-4-aminophenol is one of the preferred aminophenol and combination of aminophenol and hydroquinone is known to provide benefit. As to the particularly amounts of the components, note, different in concentration will not support the patentability of subject matter encompassed by prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable range by routine experimentation. *In re Aller*, 220 F 2d 454, 105 USPQ 233, 235 (CCPA 1955).

*Response to the Arguments*

Applicants' amendments, remarks, and declaration under 37 C.F. R. 132 have been fully considered, but are not persuasive with respect to the rejections set forth above.

While the declaration and remarks convincingly demonstrate the unexpected result of the particular combination (N-cholesteryloxycarbonyl-4-aminophenol and hydroquinone) at a particular concentration (8x10<sup>-5</sup> M of hydroquinone, and 6.77x10<sup>-5</sup> M of N-cholesteryloxycarbonyl-4-aminophenol), the unexpected results do not commensurate with the scope of claimed invention, which encompassed large number of structurally different hydroquinone compounds, and much high concentration (0.5 to 1% of hydroquinone, which is

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about 0.05 to 0.1 M). Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant's burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in the scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, A DECLARATION UNDER 37 CFR 1.1323 must compare the claimed subject matter with the closest prior art in order to be effective to rebut a prima facie case if obviousness. See, MPEP 716.02 (e).

For reasons discussed above, the claims have been properly rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.



SHENGJUN WANG  
PRIMARY EXAMINER

Shengjun Wang

May 15, 2004